REMARKS

REVIEW

The current application sets forth claims 1-7 of which claims 1 and 5 are independent claims. Presently, no claims have been indicated as allowed in view of the prior art. Claims 1-7 stand collectively rejected under 35 U.S.C. § 103(a) as being unpatentable over Amberg et al. (U.S. Patent No. 5,091,543) in view of Rickel et al. (U.S. Patent No. 5,854,924).

DRAWINGS

It is hereby noted that the Examiner's original objection to the drawings has been withdrawn in light of Applicant's earlier amendments.

SPECIFICATION

It is hereby noted that the Examiner's objection to the original specification has been withdrawn in light of Applicant's earlier amendments.

35 U.S.C. § 103(a) REJECTIONS

The Examiner has rejected Claims 1-7 under 35 U.S.C. § 103(a) as being unpatentable over Amberg et al. in view of Rickel et al. Applicant respectfully traverses such ground of rejection. By relying on rejection grounds under 35 U.S.C. § 103(a) for alleged obviousness, and by various statements throughout the detailed Office Action, the Examiner already acknowledges certain

important deficiencies of the base reference Amberg et al. which renders such reference inadequate for serving by itself as a rejection basis for any of the present pending claims.

With respect to independent claims 1 and 5, it is respectfully submitted that Amberg et al. cannot at law serve as an anticipating reference under 35 U.S.C. § 103(a). As the proposed secondary reference, Rickel et al., fails to overcome the faults of the base reference, it is respectfully submitted that all claims are presently in condition for allowance.

An invention is only obvious under 35 U.S.C. §103(a) if "there is something in the prior art as a whole to suggest the desirability, thus the obviousness, of making the combination." Lindermann Maschinenfabrik GMBH v. American Hoist and Derrick Comp., et al., 730 F.2d 1452, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984). If a reference would be "rendered inoperable for its intended purpose" when it is modified for use as prior art, then the reference "teaches away" and should not be used. In re Gordon et al., 733 F.2d 900, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path taken by the applicant. ...[I]n general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." In re Gurley, 2 F.3d 551, 31 U.S.P.Q.2d 1130, 1131 (Fed. Cir. 1994).

It is respectfully submitted that the proposed combination of Amberg et al. and Rickel et al. is improper as there exists no motive to combine the references. Despite the lack of motivation to

combine, should such combination of references be held suitably proper, it is respectfully submitted that such combination teaches away from the present invention.

As previously amended, independent claim 1 of the present invention is specifically directed to a method of testing a downloading and installation process. More specifically, claim 1 was amended to recite that it functioned not on the computer that would be subject to the download and installation of software but instead on a separate simulation computer. As such, the Examiner has acknowledged that Amberg et al. is insufficient by itself to serve as a rejection basis for the present application. The Examiner, however, holds the position that the debugging methodology of Rickel et al. is sufficiently similar to the present invention to combine with Amberg et al. and obviate the present invention.

It is the position of Applicant that there exists a fundamental difference between the debugging process of Rickel et al. ad the process of the present invention. Specifically, the debugging tool of Rickel et al. is designed to simulate the running of a software program on a target computer, to locate errors in the program and to report such errors back to the programmer for correction. Claim 1 of the present invention is directed to a method of simulating the downloading and installation of the customer ordered software to a target computer. The debugging of the software itself is immaterial and complete by such time as the present invention would play any part in the preparation and completion of a designed-to-order PC. As such, it is believed that there exists no motivation to combine such references.

Alternatively, should such combination be held proper, it is respectfully submitted that the combination would teach away from the present invention as the combination would result in a

simulation tool for simulating the running of software on a target computer and not a method for simulating the downloading and installation of software on a target computer. Inherently, the former assumes the successful downloading and installation of such software to have already occurred. As a result, the proposed process may indeed be described as "analogous art", however, the present invention is wholly different from the proposed combination.

It is therefore submitted that the use of Amberg et al. as a basis for the 35 U.S.C. §103(a) rejection of claims 1-7 is improper as there is no motivation to combine the proposed references and even should such combination be deemed proper, the resulting prior art would teach away from the present invention. As such, and for all the same reasons as above stated, it is believed that independent claims 1 and 5 are in condition for allowance. Furthermore, claims 2-4 depend from and further limit claim 1 and are therefore allowable on the same basis as claim 1. Similarly, claims 6 and 7 depend from and further limit claim 5 and are therefore allowable on the same basis as claim 5. Withdrawal of the current grounds of the 35 U.S.C. §103(a) rejection of claims 1-7 is respectfully requested and earnestly solicited.

CITED RELEVANT PRIOR ART

It is not believed that any of the prior art cited either by the Examiner or the Applicant, alone or in combination either with each other or other cited prior art teaches, discloses, suggests or makes obvious the claimed features of the present invention.

CONCLUSION

In view of Applicant's earlier amendments and the foregoing comments, Applicants respectfully request withdrawal of the current grounds of rejection and the issuance of a formal Notice of Allowance. The Examiner is invited to telephone the undersigned at his convenience should only minor issues remain after consideration of this amendment in order to permit early resolution of the same.

It is believed that no fee is due with the present amendment, however, if it is determined that a fee is due, the Commissioner is hereby authorized to charge any fee required to Deposit Account No. 50-0686, in the name of Lanier Ford Shaver & Payne P.C.

Respectfully submitted,

7/6/04
Date

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